

REMARKS

[0002] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. The status of the claims is as follows:

- Claims 1-38 are currently pending
- Claims 1-17, 19, 21, 23-27 and 31-36 are amended herein

[0003] Support for the amendments to claims 1-17, 19-21, 23-27 and 31-36 is found in the specification of instant application with U.S. Patent Application Publication with Number 2005/0156873 at least at Paragraphs [0017], [0018], [0028], [0033], [0036], [0055] – [0064], and FIG. 7 and 8.

Cited Documents

[0004] The following documents have been applied to reject one or more claims of the Application:

- **Challapali:** *Kiran Challapali*, U.S. Patent Application Publication No. **2002/0194006**
- **Hyon:** *Seung-Taek Hyon*, U.S. Patent Application Publication No. **2002/0077135**
- **Heikes:** *Heikes et al.*, U.S. Patent Application Publication No. **2003/0225848**
- **Werndorfer:** *Werndorfer et al.*, U.S. Patent Application Publication No. **2004/0024822**
- **AllAlias.com:** "**MUST READ: Signature/Avatar Rules**", retrieved 6/7/2008 at <<<http://web.archive.org/web/20031002014646/forums.allalias.com/index.php?>>>, AllAlias.com, May 23, 2003, pp 1-8
- **Chodor:** *Chodor, et al.*, U.S. Patent Application Publication No. **20020036990**

- **Hickman:** *Hickman, et al.*, U.S. Patent No. **7,013,327**
- **Dawson:** *Dawson*, U.S. Patent No. **6,252,588**
- **Day:** *Day, et al.*, U.S. Patent Application Publication No. **20050027839**
- **Jilk:** *Jilk, et al.*, U.S. Patent Application Publication No. **20020010746**
- **Goodwin:** *Goodwin, et al.*, U.S. Patent Application Publication No. **20020065931**
- **Goldschneider:** *Goldschneider, et al.*, U.S. Patent Application Publication No. **20020107925**
- **Huntington:** *Huntington, et al.*, U.S. Patent Application Publication No. **20030131098**
- **Zhao:** *Zhao*, U.S. Patent No. **7,353,253**

Claims 1, 2, 4, 6, 11, 12, 14, 21, 23-25, 30, 31, 33, 35 and 36 Are Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer

[0005] Claims 1, 2, 4, 6, 11, 12, 14, 21, 23-25, 30, 31, 33, 35 and 36 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer. Applicant respectfully traverses the rejection.

Independent Claim 1

[0006] Applicant submits that amended independent claim 1 is not obvious in view of the combination of Challapali, Hyon, Heikes and Werndorfer. Applicant submits that the combination of Challapali, Hyon, Heikes and Werndorfer does not teach or suggest at least the following features of this claim, as amended (with emphasis added):

- selecting, by a user via a user-input device of a sender, a still image that includes a single array grid of pixels, wherein the still image is not part of an existing character set stored on the sender;
- creating, by a pixel array generator of the sender, a custom graphical emoticon from the selected still image so that the still image is used as the custom graphical emoticon;
- obtaining a character sequence from the user via the user-input device of the sender;
- assigning the character sequence to the custom graphical emoticon, the character sequence representing the custom graphical emoticon so as to act as a placeholder for the custom graphical emoticon;
- obtaining a message from the user via the user-input device of the sender, the message including textual content with the emoticon-placeholder character sequence embedded therein;
- transmitting the message from the sender to a destination via a message-transmission modality of transmission, the transmitted message including the textual content with the emoticon-placeholder character sequence embedded therein; and
- **separately from the transmitting of the message, sending the custom graphical emoticon to the destination via a different modality of transmission than the message-transmission modality of transmission.**

[0007] Amended claim 1 recites in part, “selecting, by a user via a user-input device of a sender, a still image that includes a single array grid of pixels, wherein the still image is not part of an existing character set stored on the sender.” Nowhere in the cited documents of record teaches or suggests this feature. Specifically, although Challapali describes that a user can input a text on one client system and a corresponding animated face image is generated on another client system (see

Paragraphs [0020] and [0021] for example), Challapali however fails to teach or suggest **"selecting, by a user via a user-input device of a sender, a still image that includes a single array grid of pixels, wherein the still image is not part of an existing character set stored on the sender"** as currently recited in this claim.

[0008] Neither Hyon is able to remedy this deficiency of Challapali. Specifically, Hyon fails to teach or suggest "selecting, by a user via a user-input device of a sender, a still image that includes a single array grid of pixels, wherein the still image is not part of an existing character set stored on the sender" as recited in claim 1.

[0009] Furthermore, claim 1 previously recites in part "creating, by a pixel array generator, an emoticon pixel set by a sender by selecting a single set of pixels to be used as the emoticon pixel set." The Office cites Paragraphs [0020] and [0021] of Challapali as allegedly teaching this feature. Applicant respectfully disagrees.

[0010] Nevertheless, for the sole purpose of expediting prosecution and without commenting on the propriety of the Office's rejections, Applicant herein amends claim 1 to highlight the differences between the instant application and the cited documents. Specifically, claim 1 currently recites in part "creating, by a pixel array generator of the sender, a custom graphical emoticon from the selected still image so that the still image is used as the custom graphical emoticon." Nowhere in Challapali is there any teaching or suggestion of this feature. Specifically, Challapali merely describes that a user can input a text on one client system and a corresponding animated face image is generated on another client system (see Paragraphs [0020] and [0021] for example). Challapali however does not teach or suggest "creating ... a custom graphical emoticon from the selected still image" as recited in this claim.

[0011] Neither Hyon is able to remedy this deficiency of Challapali. Specifically, Hyon merely describes that “[a]n emoticon is defined as a hieroglyphic character that is formed using a plurality of typical characters or special characters in combination to represent a user’s emotions.” Hyon however does not teach or suggest “creating ... a custom graphical emoticon from the selected still image” as currently recited in this claim.

[0012] Moreover, claim 1 currently recites in part, “separately from the transmitting of the message, sending the custom graphical emoticon to the destination via a different modality of transmission than the message-transmission modality of transmission.” Nowhere in Challapali or Hyon is there any teaching or suggestion this feature. Specifically, Challapali does not send any “custom graphical emoticon to the destination”, not to mention “via a different modality of transmission than the message-transmission modality of transmission” as recited in this claim. On the other hand, Hyon merely describes sending his defined emoticon with the message to a recipient. (See Paragraph [0042] of Hyon for example.) Hyon however fails to teach or suggest “separately from the transmitting of the message, sending the custom graphical emoticon to the destination via a different modality of transmission than the message-transmission modality of transmission” as recited in claim 1.

[0013] Furthermore, none the other cited documents of record – Heikes, Werndorfer, AllAlias.com, Chodor, Hickman, Dawson, Day, Jilk, Goodwin, Goldschneider, Huntington and Zhao – is able to remedy the above deficiencies of Challapali and Hyon. Specifically, they are either irrelevant to any acts related to “custom graphical

emoticon”, for example, the acts of creating and sending, or fail to teach or suggest the specific features in this claim.

[0014] Consequently, the combination of Challapali, Hyon, Heikes, Werndorfer, AllAlias.com, Chodor, Hickman, Dawson, Day, Jilk, Goodwin, Goldschneider, Huntington and Zhao does not teach or suggest all of the elements and features of this claim. Accordingly, Applicant respectfully requests that the rejection of this claim be withdrawn.

Dependent Claims 2, 4, 6, 11 and 12

[0015] Claims 2, 4, 6, 11 and 12 ultimately depend from independent claim 1. As discussed above, claim 1 is allowable over the cited documents. Therefore, claims 2, 4, 6, 11 and 12 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Independent Claim 14

[0016] Applicant submits that the Office has not made a *prima facie* showing that independent claim 14 is obvious in view of the combination of the combination of Challapali, Hyon, Heikes and Werndorfer. The Office states that “[a]s to claims 14, 23, and 35, the claims are rejected for reasons similar to claim 1 above.” (See Page 11 of the Action.) Applicant respectfully disagrees.

[0017] Applicant respectfully points out that the Office has failed to address the specific claim language of claim 14. The claim language of claim 14 is different from that of claim 1 at least, for example, “retrieving the array grid of pixels using the

character sequence,” “the character sequence is mappable to an array grid of pixels residing outside the communication,” and “replacing the character sequence within the text message in the communication with the array grid of pixels.”

[0018] It is not that the Office disagreed about whether specific claim language distinguishes the claims from the cited references. Rather, it appears that the Office has not addressed with particularity whether the particular claim language of this claim distinguishes this claim from the cited references. The Office provides little to no explanation as to how the components of the cited references correspond to the actual claim language of this claim. Furthermore, the Office provides little or no explanation as to how the operation of components of the cited reference corresponds to that of the actual claim language of this claim.

[0019] Since the Office has provided little or no reasoning for its rejections, Applicant can do little more than gainsay. Applicant is forced to make assumptions and guesses as to the Office’s specific reasoning. Therefore, Applicant submits that it has been denied its right to adequately and effectively respond to the Office’s rejections.

[0020] In *In re Lee*, 61 USPQ2d 1430 (CA FC 2002), the Federal Circuit explained the following on page 1433:

The Administrative Procedure Act, which governs the proceedings of administrative agencies [such as the Patent and Trademark Office] and related judicial review, establishes a scheme of “reasoned decisionmaking.” Not only must an agency’s decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational. Allentown Mack Sales and Service, Inc. v. National Labor Relations Bd., 522 U.S. 359, 374 (1998) (citation omitted).

This standard requires that the agency not only have reached a sound decision, but have *articulated the reasons for that decision*. The reviewing court is thus enabled to perform meaningful review within the strictures of the APA, for the court will have a basis on which to determine “whether

the decision was based on the relevant factors and whether there has been a clear error of judgment." *Citizens to Preserve Overton Park v. Volpe*, 401 U.S. 402, 416 (1971). [emphasis added]

[0021] Applicant submits that the Office has generally failed to articulate the reasons for its decision-making. Accordingly, Applicant respectfully requests that the next action – if not a Notice of Allowance – be Non-Final.

Independent Claim 21

[0022] Applicant submits that the Office has not made a *prima facie* showing that independent claim 21 is obvious in view of the combination of the combination of Challapali, Hyon, Heikes and Werndorfer. The Office states that "[a]s to claim 21, the claim is rejected for reasons similar to claims 1 and 6 above." (See Page 11 of the Action.) Applicant respectfully disagrees.

[0023] Applicant respectfully points out that the Office has failed to address the specific claim language of claim 21. The claim language of claim 21 is different from those of claims 1 and 6 at least, for example, "a means for mapping the character sequence in the real-time first communication with the graphics data from the second communication."

[0024] As a result, Applicant submits that the Office has generally failed to articulate the reasons for its decision-making. Accordingly, Applicant respectfully requests that the next action – if not a Notice of Allowance – be Non-Final.

Independent Claim 23

[0025] Applicant submits that the Office has not made a *prima facie* showing that independent claim 23 is obvious in view of the combination of the combination of

Challapali, Hyon, Heikes and Werndorfer. The Office states that “[a]s to claims 14, 23 and 35, the claims are rejected for reasons similar to claim 1 above.” (See Page 11 of the Action.) Applicant respectfully disagrees.

[0026] Applicant respectfully points out that the Office has failed to address the specific claim language of claim 23. The claim language of claim 23 is different from that of claim 1 at least, for example, previously presented claim recitation of “an image selector to create an emoticon from an image, wherein the emoticon is representable as a single set of pixels,” or currently amended claim recitation of “an image selector configured to create a custom graphical emoticon from a still image, wherein the custom graphical emoticon is representable as a single array grid of pixels.”

[0027] As a result, Applicant submits that the Office has generally failed to articulate the reasons for its decision-making. Accordingly, Applicant respectfully requests that the next action – if not a Notice of Allowance – be Non-Final.

Dependent Claims 24 and 25

[0028] Claims 24 and 25 ultimately depend from independent claim 23. As discussed above, claim 23 is allowable over the cited documents. Therefore, claims 24 and 25 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Independent Claim 30

[0029] Applicant submits that the Office has not made a *prima facie* showing that independent claim 30 is obvious in view of the combination of the combination of

Challapali, Hyon, Heikes and Werndorfer. The Office states that “[a]s to claim 30, the claim is rejected for reasons similar to claim 24 above,” and “[a]s to claim 24, the claim is rejected for reasons similar to claim 1 above.” (See Page 11 of the Action.) Applicant respectfully disagrees.

[0030] Applicant respectfully points out that the Office has failed to address the specific claim language of claim 30. The claim language of claim 30 is different from that of claim 1 at least, for example, the previously presented claim recitation of “creating an emoticon by selecting an image associated with the emoticon by a sender” and “representing the image as single set of pixels for the emoticon”, or the currently amended claim recitation of “creating a custom graphical emoticon by selecting an image associated with the custom graphical emoticon by a sender” and “representing the image as a single array grid of pixels for the custom graphical emoticon.”

[0031] As a result, Applicant submits that the Office has generally failed to articulate the reasons for its decision-making. Accordingly, Applicant respectfully requests that the next action – if not a Notice of Allowance – be Non-Final.

Dependent Claims 31, 33, 35 and 36

[0032] Claims 31, 33, 35 and 36 ultimately depend from independent claim 30. As discussed above, claim 30 is allowable over the cited documents. Therefore, claims 31, 33, 35 and 36 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Claim 3 Is Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer, further in view of AllAlias.com

[0033] Claim 3 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer, further in view of AllAlias.com. Applicant respectfully traverses the rejection.

Dependent Claim 3

[0034] Claim 3 ultimately depends from independent claim 1. As discussed above, claim 1 is allowable over the cited documents. Therefore, dependent claim 3 is also allowable over the cited documents of record for at least its dependency on an allowable base claim. Additionally, this claim may also be allowable for the additional features that it recites.

Claims 5, 7, 26, 28, 29, and 32 Are Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer, further in view of Chodor

[0035] Claims 5, 7, 26, 28, 29, and 32 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer, further in view of Chodor. Applicant respectfully traverses the rejection.

Dependent Claims 5 and 7

[0036] Claims 5 and 7 ultimately depend from independent claim 1. As discussed above, claim 1 is allowable over the cited documents. Therefore, claims 5 and 7 are also allowable over the cited documents of record for at least their dependency from an

allowable base claim. These claims may also be allowable for the additional features that each recites.

Dependent Claims 26, 28 and 29

[0037] Claims 26, 28 and 29 ultimately depend from independent claim 23. As discussed above, claim 23 is allowable over the cited documents. Therefore, claims 26, 28 and 29 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Dependent Claim 32

[0038] Claim 32 ultimately depends from independent claim 30. As discussed above, claim 30 is allowable over the cited documents. Therefore, claim 32 is also allowable over the cited documents of record for at least its dependency from an allowable base claim. This claim may also be allowable for the additional features that it recites.

Claims 8-10, 15, 16, 27, and 34 Are Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer, further in view of Chodor, and further in view of Hickman

[0039] Claims 8-10, 15, 16, 27, and 34 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer, further in view of Chodor, and further in view of Hickman. Applicant respectfully traverses the rejection.

Dependent Claims 8-10

[0040] Claims 8-10 ultimately depend from independent claim 1. As discussed above, claim 1 is allowable over the cited documents. Therefore, claims 8-10 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Dependent Claims 15 and 16

[0041] Claims 15 and 16 ultimately depend from independent claim 14. As discussed above, claim 14 is allowable over the cited documents. Therefore, claims 15 and 16 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Dependent Claim 27

[0042] Claim 27 ultimately depends from independent claim 23. As discussed above, claim 23 is allowable over the cited documents. Therefore, claim 27 is also allowable over the cited documents of record for at least its dependency from an allowable base claim. This claim may also be allowable for the additional features that it recites.

Dependent Claim 34

[0043] Claim 34 ultimately depends from independent claim 30. As discussed above, claim 30 is allowable over the cited documents. Therefore, claim 34 is also allowable over the cited documents of record for at least its dependency from an allowable base claim. This claim may also be allowable for the additional features that it recites.

Claims 8-10, 15, 16, 27, and 34 Are Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer, further in view of Chodor, and further in view of Dawson

[0044] Claims 8-10, 15, 16, 27, and 34 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer, further in view of Chodor, and further in view of Dawson. Applicant respectfully traverses the rejection.

Dependent Claims 8-10

[0045] Claims 8-10 ultimately depend from independent claim 1. As discussed above, claim 1 is allowable over the cited documents. Therefore, claims 8-10 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Dependent Claims 15 and 16

[0046] Claims 15 and 16 ultimately depend from independent claim 14. As discussed above, claim 14 is allowable over the cited documents. Therefore, claims 15 and 16 are also allowable over the cited documents of record for at least their dependency from an allowable base claim. These claims may also be allowable for the additional features that each recites.

Dependent Claim 27

[0047] Claim 27 ultimately depends from independent claim 23. As discussed above, claim 23 is allowable over the cited documents. Therefore, claim 27 is also allowable

over the cited documents of record for at least its dependency from an allowable base claim. This claim may also be allowable for the additional features that it recites.

Dependent Claim 34

[0048] Claim 34 ultimately depends from independent claim 30. As discussed above, claim 30 is allowable over the cited documents. Therefore, claim 34 is also allowable over the cited documents of record for at least its dependency from an allowable base claim. This claim may also be allowable for the additional features that it recites.

Claim 13 Is Non-Obvious Over Challapali, Hyon, Werndorfer and Heikes, further in view of Day

[0049] Claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer, further in view of Day. Applicant respectfully traverses the rejection.

Dependent Claim 13

[0050] Claim 13 ultimately depends from independent claim 1. As discussed above, claim 1 is allowable over the cited documents. Therefore, dependent claim 13 is also allowable over the cited documents of record for at least its dependency on an allowable base claim. Additionally, this claim may also be allowable for the additional features that it recites.

Claim 17 Is Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer, further in view of Jilk

[0051] Claims 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer, further in view of Jilk. Applicant respectfully traverses the rejection.

Dependent Claim 17

[0052] Claim 17 ultimately depends from independent claim 14. As discussed above, claim 14 is allowable over the cited documents. Therefore, dependent claim 17 is also allowable over the cited documents of record for at least its dependency on an allowable base claim. Additionally, this claim may also be allowable for the additional features that it recites.

Claim 18 Is Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer, and Jilk, further in view of Goodwin

[0053] Claim 18 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes, Werndorfer and Jilk, further in view of Goodwin. Applicant respectfully traverses the rejection.

Dependent Claim 18

[0054] Claim 18 ultimately depends from independent claim 14. As discussed above, claim 14 is allowable over the cited documents. Therefore, dependent claim 18 is also allowable over the cited documents of record for at least its dependency on an

allowable base claim. Additionally, this claim may also be allowable for the additional features that it recites.

Claim 19 Is Non-Obvious Over Challapali, Hyon, Heikes and Werndorfer, further in view of Jilk, further in view of Goldschneider, and further in view of Huntington

[0055] Claim 19 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer, further in view of Jilk, further in view of Goldschneider, and further in view of Huntington. Applicant respectfully traverses the rejection.

Dependent Claim 19

[0056] Claim 19 ultimately depends from independent claim 14. As discussed above, claim 14 is allowable over the cited documents. Therefore, dependent claim 19 is also allowable over the cited documents of record for at least its dependency on an allowable base claim. Additionally, this claim may also be allowable for the additional features that it recites.

Claim 20 Is Non-Obvious Over Challapali, Hyon, Heikes, Werndorfer, Jilk, Goldschneider, and Huntington, and further in view of Zhao

[0057] Claim 20 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes, Werndorfer, Jilk, Goldschneider, and Huntington, and further in view of Zhao. Applicant respectfully traverses the rejection.

Dependent Claim 20

[0058] Claim 20 ultimately depends from independent claim 14. As discussed above, claim 14 is allowable over the cited documents. Therefore, dependent claim 20 is also allowable over the cited documents of record for at least its dependency on an allowable base claim. Additionally, this claim may also be allowable for the additional features that it recites.

Claim 22 Is Non-Obvious Over Challapali, Hyon, Heikes, Werndorfer and Official Notice

[0059] Claim 22 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes and Werndorfer with Official Notice. Applicant respectfully traverses the rejection.

Dependent Claim 22

[0060] Claim 22 ultimately depends from independent claim 21. As discussed above, claim 21 is allowable over the cited documents. Therefore, dependent claim 22 is also allowable over the cited documents of record for at least its dependency on an allowable base claim. Additionally, this claim may also be allowable for the additional features that it recites.

Claim 37 Is Non-Obvious Over Challapali, Hyon, Heikes, Werndorfer, Chodor and Dawson

[0061] Claim 37 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes, Werndorfer, Chodor and Dawson. Applicant respectfully traverses the rejection.

Independent Claim 37

[0062] Applicant respectfully submits that the Office has not made a *prima facie* showing that independent claim 37 is obvious in view of the combination of the combination of Challapali, Hyon, Heikes, Werndorfer, Chodor and Dawson. Applicant submits that the combination of Challapali, Hyon, Heikes, Werndorfer, Chodor and Dawson does not teach or suggest at least the following features of this claim, as amended (with emphasis added):

- creating, by a pixel array generator, an emoticon pixel set by a sender by selecting a single set of pixels, which is a custom emoticon;
- storing the emoticon pixel set in a custom emoticon object store of the sender;
- transferring the emoticon pixel set to a destination from the custom emoticon object store of the sender, wherein the transferring comprises establishing a real-time peer-to-peer link between the sender and the destination to retrieve the emoticon pixel set from the custom emoticon object store of the sender;
- **sending instructions to the destination on how to retrieve the emoticon pixel set;**
- mapping the character sequence to the emoticon pixel set using a keyboard device;

- parsing the character sequence into an object name for the pixel emoticon set, wherein the object name includes both an identifier and a location of the pixel emoticon set;
- storing the identifier and the location in a header of a text message;
- transmitting, to the destination, the text message by a sender, the text message including the character sequence, which was mapped to the pixel emoticon set, the destination being configured to identify and locate the transferred emoticon pixel set at the destination using the identifier and the location transmitted in the header of the text message, wherein both of the text message and the emoticon pixel set are displayed on a screen of the destination, the emoticon pixel set being substituted at the destination within the text message for the character sequence mapped to the emoticon pixel set within the text message, **the emoticon pixel set being transferred from the sender to the destination separately from the transmission of the text message from the sender to the destination.**

[0063] The Office states that “[a]s to claim 37, the claim is rejected for reasons similar to claims 1, 5, 8 and 25 above.” Applicant respectfully disagrees. Applicant respectfully points out that the Office has failed to address the specific claim language of claim 37. The claim language of claim 37 is different from those of claims 1, 5, 8 and 25 at least, for example, “sending instructions to the destination on how to retrieve the emoticon pixel set.” As a result, Applicant submits that the Office has generally failed to articulate the reasons for its decision-making. Accordingly, Applicant respectfully requests that the next action – if not a Notice of Allowance – be Non-Final.

[0064] Furthermore, claim 27 recites in part that, “the emoticon pixel set being transferred from the sender to the destination separately from the transmission of the

text message from the sender to the destination.” Nowhere in the cited documents of record teach or suggest this feature. Specifically, Challapali does not transfer any “emoticon pixel set ... to the destination”, not to mention “to the destination separately from the transmission of the text message from the sender to the destination” as recited in this claim. On the other hand, Hyon merely describes sending his defined emoticon with the message to a recipient. (See Paragraph [0042] of Hyon for example.) Hyon however fails to teach or suggest that “the emoticon pixel set being transferred from the sender to the destination separately from the transmission of the text message from the sender to the destination” as recited in claim 37.

[0065] Neither the other cited documents of record are able to remedy these deficiencies of Challapali and Hyon. Specifically, the other cited documents of record are either irrelevant to any acts related to “emoticon pixel set”, for example, the act of separately transferring, or fail to teach or suggest the specific features in this claim.

[0066] Furthermore, in light of an informal discussion with the Examiner, Applicant submits that the rejection of independent claim 37 is moot. Specifically, Applicant understood the Examiner to tentatively agree that claim 37 is allowable at least over the cited documents of record. More specifically, the Examiner has tentatively agreed that the cited documents do not teach or suggest at least the above highlighted features.

Claim 38 Is Non-Obvious Over Challapali, Hyon, Heikes, Werndorfer, Dawson, Jilk, Goldschneider and Huntington

[0067] Claims 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Challapali, Hyon, Heikes, Werndorfer, Dawson, Jilk, Goldschneider and Huntington. Applicant respectfully traverses the rejection.

Independent Claim 38

[0068] Applicant respectfully submits that the Office has not made a *prima facie* showing that independent claim 38 is obvious in view of the combination of the combination of Challapali, Hyon, Heikes, Werndorfer, Dawson, Jilk, Goldschneider and Huntington. Applicant submits that the combination of Challapali, Hyon, Heikes, Werndorfer, Dawson, Jilk, Goldschneider and Huntington does not teach or suggest at least the following features of this claim, as amended (with emphasis added):

[0069] Claim 38 recites the following features (with emphasis added):

- receiving a communication by a message receiver, wherein the communication comprises:
 - a text message, the text message including a custom-emoticon-mapped character sequence, which is mapped to custom emoticon pixel set, which is defined set of pixels a residing outside the communication; and
 - a header storing at least one of an identifier and a location of the custom emoticon pixel set, the identifier and the location comprising at least part of an object name for the custom emoticon pixel set;
- **determining whether the custom emoticon pixel set is stored in a local storage medium of the message receiver, wherein the determining utilizes the identifier and the location;**

- in response to the determining, retrieving the custom emoticon pixel set from the local storage medium of the message receiver;
- otherwise, retrieving the custom emoticon pixel set from a storage medium associated with the sender of the communication or with a server, in which the communication did not originate;
- displaying the text message in a screen, the custom emoticon pixel set being displayed instead of and in place of the custom-emoticon-mapped character sequence in the text message.

[0070] The Office states that “[a]s to claim 38, the claim is rejected for reasons similar to claims 1, 15, 17 and 19.” Applicant respectfully disagrees. Applicant respectfully points out that the Office has failed to address the specific claim language of claim 38. The claim language of claim 38 is different from those of claims 1, 15, 17 and 19 at least, for example, “determining whether the custom emoticon pixel set is stored in a local storage medium of the message receiver, wherein the determining utilizes the identifier and the location.,” “in response to the determining, retrieving the custom emoticon pixel set from the local storage medium of the message receiver” and “otherwise, retrieving the custom emoticon pixel set from a storage medium associated with the sender of the communication or with a server, in which the communication did not originate.” As a result, Applicant submits that the Office has generally failed to articulate the reasons for its decision-making. Accordingly, Applicant respectfully requests that the next action – if not a Notice of Allowance – be Non-Final.

[0071] Furthermore, in light of an informal discussion with the Examiner, Applicant submits that the rejection of independent claim 38 is moot. Specifically, Applicant understood the Examiner to tentatively agree that claim 38 is allowable at least over the

cited documents of record. More specifically, the Examiner has tentatively agreed that the cited documents do not teach or suggest at least the above highlighted features.

Conclusion

[0072] For at least the foregoing reasons, all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application.

[0073] If any issues remain that would prevent allowance of this application, Applicant requests that the Examiner contact the undersigned representative before issuing a subsequent Action.

Respectfully Submitted,

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